

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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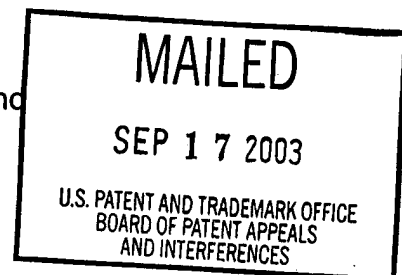
**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JASPER D. RINE,  
VICTOR L. BOYARTCHUK, and  
MATTHEW N. ASHBY

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Appeal No. 2003-1998  
Application No. 09/165,460



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**ORDER REMANDING TO THE EXAMINER**

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Before Stoner, Chief Administrative Patent Judge,  
HARKCOM, Vice Chief Administrative Patent Judge, and  
WILLIAM F. SMITH, Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

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**REMAND TO THE EXAMINER**

The examiner entered an Examiner's Answer on May 20, 2003 (Paper No. 24).  
A Reply Brief was received by the U.S. Patent & Trademark Office (USPTO) on August 25, 2003, bearing a "Certificate of Mailing" stating that the correspondence was deposited with the U.S. Postal Service on August 19, 2003. To date, the examiner has

not had an opportunity to review the Reply Brief. Accordingly, we remand the application to the examiner to consider the Reply Brief. In so doing, the examiner should note that the Reply Brief appears to be untimely as it was due within two months from the date of the Examiner's Answer. 37 CFR § 1.193(b)(1). We note appellants state in the last paragraph of the Reply Brief that they petitioned for and authorized charging to their deposit account all necessary extensions of time. However, extensions of time for filing a reply brief are governed by 37 CFR § 1.136(b). See 37 CFR § 1.136(a)(1)(ii).

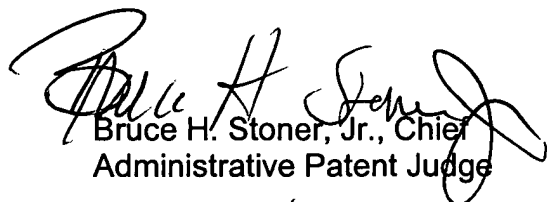

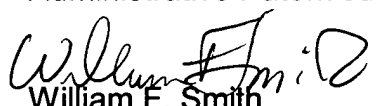
Apart from the timeliness issue in regard to the filing of the Reply Brief, there is another issue raised in this appeal the examiner should consider upon return of the application. Appellants question in the Appeal Brief the publication date of the references relied upon by the examiner identified as Rose and Lye. In response, the examiner introduced and relied upon new evidence in the Examiner's Answer, i.e., copies of e-mail messages received by USPTO personnel purporting to establish a publication date for the Rose and Lye references. The propriety of the examiner relying upon new evidence in the Examiner's Answer is not apparent. See 37 CFR § 1.193(a)(2) ("[a]n examiner's answer must not include a new ground of rejection . . .") Applicants state in the Reply Brief that they have had "no opportunity to confront this new evidence." Id., page 1.

An appeal should be decided upon a fixed record, not an ever expanding record. Here, the examiner apparently acquiesced in appellants' argument that the record at the time of the Appeal Brief did not establish that the Rose and Lye publications were publicly available at a time that would qualify them as prior art to the claims on appeal. Rather, the examiner introduced new evidence in an effort to establish that the Rose and Lye references do, in fact, qualify as prior art. However, appellants have not had a full and fair opportunity to respond to the new evidence.

Upon return of the application, the examiner should review the matter and take appropriate action. It appears that the examiner has two options. If the examiner believes the record at the time of the Appeal Brief was sufficient to establish that the Rose and Lye references are available as prior art to the claims under appeal, the examiner could withdraw the original Examiner's Answer and substitute an Examiner's Answer which does not reply upon new evidence, explaining why the facts of record at the time of the Appeal Brief are sufficient. On the other hand, if the examiner agrees with appellants that the facts of record at the time of the Appeal Brief do not establish that the Rose and Lye references are available as prior art and the examiner continues to believe that the new evidence establishes that the Rose and Lye references are available as prior art to the claims on appeal, the examiner should reopen prosecution and allow appellants a full and fair opportunity to respond to the new evidence.

This application, by virtue of its "special" status, requires an immediate action.  
Manual of Patent Examining Procedure § 708.01 (8th ed., rev. 1, February 2003). It is  
important that the Board be informed promptly of any action affecting the appeal in this  
case.

**REMANDED**

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Bruce H. Stoner, Jr., Chief	)	
Administrative Patent Judge	)	
	)	
Gary V. Harkcom, Vice Chief	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
William F. Smith	)	
Administrative Patent Judge	)	

Appeal No. 2003-1998  
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